



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/083,409	02/27/2002	Masaya Nagata	1248-0580P-SP	7393

2292 7590 12/10/2008
BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

SHEIKH, ASFAND M

ART UNIT	PAPER NUMBER
----------	--------------

3627

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

12/10/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

10/083,409

Applicant(s)

NAGATA, MASAYA

Examiner

Asfand M. Sheikh

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period **will** apply and **will** expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply **will**, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,15,30 and 31 is/are pending in the application.
- 4a) Of the above claim(s) 3-14 and 16-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

The amendment filed on 8/26/2008 has been entered. The examiner notes claims 1, 2, 15, and 30 and 31 are pending for examination. Further, the examiner notes claims 1 and 15 have been amended and claim 30 and 31 have been added and further all other claims remain withdrawn with respect to the restriction requirement established on 12/28/2007.

Response to Arguments

Applicant's arguments filed 8/26/2008, with respect to the rejection(s) of claim(s) 1 and 15 under 35 U.S.C. 102(e) with respect to the Sekizawa et.al. (US 6,430,711 B1) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Szabo in view of Suzuki and Serber.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-2, 15, and 30-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-2, 15, and 30-31

The examiner notes that “registering unique data to specify each product-in-circulation delivered to a service receiver and expiring date data of the product-in-circulation in a terminal” is indefinite. The examiner is confused of both of the data is kept in the terminal or if just the expiring date data is based on the product in a terminal? The examiner will interpret at best understood.

The examiner notes that “calculating an account of a product-in-circulation recognized as the purchase action, out of products-in-circulation delivered to the service receiver, in accordance with the expiring date data of the product-in-circulation” is indefinite. The examiner is confused on what “an account” is? Is it an actual account that is being modified with respect to the products-in-circulation? Or is it the actual number of products-in-circulation? The examiner will interpret as best understood.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 2, and 30 are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, a 35 U.S.C § 101 process must (1) be tied to a particular machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In re Bilski et al, 88 USPQ 2d 1385 CAFC (2008); Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the particular machine to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps are not tied to a particular machine and do not perform a transformation. Thus, the claims are non-statutory.

The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101.

Note the Board of Patent Appeals Informative Opinion Ex parte Langemyer et al.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2,15, and 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Szabo et al. (US 6,963,851 B1) in view of Suzuki et al. (JP 07-325514) (computer translation) and Seber et al. (US 6,233,410 B1).

Claim 1-2, 15, 30-31

Szabo '851 discloses a service management method which makes a computer execute the steps of: (see at least, abstract: the examiner notes an e-commerce site storing data representing inventory) registering data to specify a product delivered to a service receiver and expiring date data of the product in a terminal (see at least, col. 2, lines 15-38: the examiner notes storing the purchase history of the items purchased and further predetermined the useful life of the product purchased and col. 7, lines 50-col. 8, lines 7: the examiner notes expiration logic utilizing expiration data registered for products (see FIG. 9)) and calculating an account of product used out of product delivered to the service receiver in accordance with the expiration date data of the product (see at least, col. 7, lines 50-col. 8, lines 7: the examiner notes expiration logic utilizing expiration data registered for products (see FIG. 9)) and col. 11, lines 14-39) and further Szabo [claim 2] discloses comprising the step of outputting an instruction to collect an unused

product-in-circulation of all products-in-circulation delivered to the service receiver, after a prescribed duration (see at least, col. 5, lines 22-26) further Szabo [claim 30-31] discloses the use of list of products that are to be changed (see at least, abstract).

Szabo fails to disclose registering unique data to specify a product-in-circulation delivered to a service receiver; detecting use of the product-in-circulation used by a service receiver via a network; recognizing the use of the product-in-circulation as a purchase action; calculating an account of a product-in-circulation recognized as the purchase action, out of products-in-circulation delivered to the service receiver.

However Suzuki discloses detecting the product-in-circulation used by a service receiver via a network (see at least, [0007]: The examiner notes collecting everything used for a copying machine (e.g. toner) and [0013]: the examiner notes a network is used for connecting the supply order accepting system to the copying machine); recognizing the use of the product-in-circulation as a purchase action and calculating an account of a product-in-circulation recognized as the purchase action, out of products-in-circulation delivered to the service receiver (see at least, [0007]: The examiner notes collecting everything used for a copying machine (e.g. toner) and [0013]: the examiner notes a network is used for connecting the supply order accepting system to the copying machine and [0017]: the examiner notes amount of orders received (e.g. total) - used (e.g. purchased)).

It would have been obvious to one of ordinary skill in the art to modify the teachings of Szabo's determining the useful life of the product purchased to include detecting the product-in-circulation used by a service receiver via a network and

recognizing the use of the product-in-circulation as a purchase action and calculating an account of a product-in-circulation recognized as the purchase action, out of products-in-circulation delivered to the service receiver as taught by Suzuki. One of ordinary skill in the art would have been motivated to combine the teachings in order to calculate an optimum dose inventory that is used and relating it to an auto supply order system (see at least, Suzuki, [0001]).

Szabo in view of Suzuki fails to disclose registering unique data to specify a product-in-circulation and detecting use of the unique product-in-circulation over the network.

However Seber discloses registering unique data to specify a product-in-circulation and detecting use of the unique product-in-circulation over the network (see at least, col. 7, lines 10-41).
used (e.g. purchased)).

It would have been obvious to one of ordinary skill in the art to modify the teachings of Szabo in view of Suzuki's recognizing of product-in-circulation to include registering unique data to specify a product-in-circulation and detecting use of the unique product-in-circulation over the network as taught by Seber. One of ordinary skill in the art would have been motivated to combine the teachings in order to providing information related to status of a packaged consumable (see at least, Seber, col. 1, lines 64-67).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Asfand M. Sheikh whose telephone number is (571)272-1466. The examiner can normally be reached on 9a-5p.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ryan M. Zeender can be reached on (571)272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Asfand M. Sheikh/
Examiner, Art Unit 3627
12/7/2008

/F. Ryan Zeender/

Supervisory Patent Examiner, Art Unit 3627